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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/732,128

12/07/2000

Michael E. Gilleland

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(12964DMUS01U)

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07/14/2005

EXAMINER

LIM, KRISNA

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ART UNIT

PAPER NUMBER

2153

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/732,128

Applicant(s)

GILLELAND, MICHAEL E.

Examiner

Krisna Lim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 1-40 are still pending for examination, and claims 41-42 are newly presented for examination.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-18 and 39-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter "method" that is mentally performed by hand with papers and pencils. Applicants are recommended to change this language to "A computer-implemented method".

4. Claims 33-38 and 41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter including an intangible media such as a data signal or a carrier signal which is incapable of being touched or perceived absent the tangible medium through which they are conveyed. It is true that an article of manufacture and a machine-readable storage medium is a statutory category of the invention (2107.01 of the MPEP), however if the specification defines this machine-readable storage medium as a data signal or a carrier wave, this machine-readable storage medium is also intangible media which is a non-statutory subject matter. Thus, the claimed invention is directed to the instructions which are not a statutory subject matter because these instructions haven't clearly claimed that they are executable by the computer. See section 2106 of the MPEP.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being un-patentable over Holden [U.S. Patent No. 6,771,639]. This reference has been used in the previous office action.

7. Holden disclosed (e.g., see Figs. 1-7) the invention substantially as claimed. Taking claims 1 and 41 as exemplary claims, the reference disclosed a method (e.g. Fig. 7) comprising:

a) receiving a call request over a network from a network entity associated with a calling party to establish an interactive call session (e.g., see 602 of Fig. 7, col. 2 (lines 16-19));

b) receiving the information about the calling party in response to looking up the information about the calling party (e.g., see 512 of Fig. 6, 608 of Fig. 7, col. 2 (lines 15-42)); and

c) providing the received information about the calling party in the call request (e.g., see 512 of Fig. 6, 608 of Fig. 7, col. 2 (lines 15-42)).

8. While on Fig. 5 Holden disclosed the feature of determine type of the call request and the feature of whether to accept or to deny the call request in Fig. 5, and on 506 and 508 Holden disclosed the feature of determine the type of message and type of

platform, Holden did not explicitly mention what kind of a method (e.g., using the table lookup method or process) is used to determine the types of call requests. It would have been obvious to one skill in the art to recognize that such as the concept of table looking is well known feature (e.g., see any computer dictionary for the teaching of table lookup concept or teaching) in the art at the time the invention was made because the use of a table lookup is known as the use of a known value (e.g., in this case a call request from a caller) to search for (e.g., to find out or to determine) data in a previous constructed table of values (e.g., a calling party in this case) is well known feature in the art

9. As to claims 2-3, Holden disclosed the feature of receiving the information from a storage device (e.g. a database stored in the storage device of SIP system #1 of Fig. 4).

10. As to claim 4, Holden disclosed the feature of receiving the information using structured query language message (e.g. see SIP message of Fig. 3, col. 6, line 54).

11. As to claim 5, Holden disclosed the feature of adding information in a body portion of the call request (e.g. see 204 of Fig. 3, col. 7, line 11).

12. As to claim 6, Holden disclosed the feature of using at least one of a Session Initiation Protocol gateway interface and Session Initiation Protocol server (e.g., see the abstract, SIP system, col. 6, line 54, to col. 8, line 20).

13. As to claims 7-9, Holden disclosed the information comprising updating a content-type field to a multipart/mixed type (e.g. see 206, 208 and 210 of Fig. 3, col. 6, line 54, to col. 7, line 35) of the call request in response to adding

the information to body portion of the call request (e.g. see 204 of Fig. 3, col. 6, line 54, to col. 7, line 35).

14. As to claim 10, Holden disclosed the feature of forwarding the call request (e.g. see 518 of Fig. 6, col. 9, lines 23-28) containing the received information to a presentation device.
15. As to claim 11, Holden disclosed the received information as Multipurpose Internet Mail Extensions type (e.g. type of cover media in message of Fig. 6, col. 9, lines 10-28).
16. As to claim 12, Holden disclosed the call request having portions according to one or more of format selected from the group considering of a Session Decryption Protocol, an audio format, a video format, a web page format and an electronic mail format (e.g. see type of platform of Fig. 6, col. 9, line 10-28).
17. As to claim 13, Holden disclosed the received call request comprising SIP message and the information about the calling party in the SIP message (e.g., see the abstract, the SIP message 200, col. 2 (lines 54-57), col. 6 (lines 54 et-seq.)).
18. As to claim 14, Holden disclosed the receiving an invite request (e.g. see col. 4 (lines 44-59) comprising SIP message and the information about the calling party in the SIP message (e.g., see the abstract, the SIP message 200, col. 2 (lines 54-57), col. 6 (lines 54 et-seq.)).
19. As to claim 15, Holden disclosed the received call request to establish a real time, interactive call session between the calling party and the called party (e.g. see col. 1, line 50, Col. 4, lines 18-33).

20. As to claim 16, Holden further disclosed the feature of determining a type of the received information and initiating a corresponding application to process the received information (e.g., see col. 1, line 50, to col. 4, lines 18-33, a determination type of the call request and the feature of whether to accept or to deny the call request in Fig. 5, and on 506 and 508 for determining the type of message and type of platform).

21. As to claim 17, Holden further disclosed a web application (e.g. see col. 8, line 63, to col. 9, line 5).

22. As to claim 18, Holden disclosed the received information is in a Multipurpose Internet Mail Extension format selected from a group consisting of Java Enhanced SIP (e.g., see SIP protocol), Hyper Text Markup Language, and Extensible Markup Language (e.g., see col. 8, line 65, to col. 9, line 5).

23. As to claims 19-40 and 42, they are similar to the claims 1-18 and 41 except with the additional feature of this calling request (e.g. an invitation message) comprising a header portion for looking up the information and a body portion for storing purchased information. While Holden disclosed the feature of using the calling party to retrieve information from a remote location (e.g. see col. 5, line 59, to col. 6, line 4), Holden did not explicitly mention that his called entity (e.g., calling request or message) comprising a header and body portions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that in the computer network all the information (data or message or request information, etc) are transferred by the use of packet technique that has at least header portion for telling the source and destination information and the body portion for storing the data.

Thus, claims 19-40 and 42 are also rejected the same reason as claims 1-18 and 42.

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24. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

26. Claims 33-38 and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter of intangible media which is incapable of being touched or perceived.

Claims 33-38 and 42 are directed to an article and a data signal embodied in a carrier wave which is not tangible embodied in a manner so as to be executable. As the only hardware (e.g., an article) is in an intended use statement which is the intent of the execution of the system and not the system itself that includes such hardware. Thus, claims 33-38 and 42 are rejected under § 101 as being incapable of being touched or perceived.

27. Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

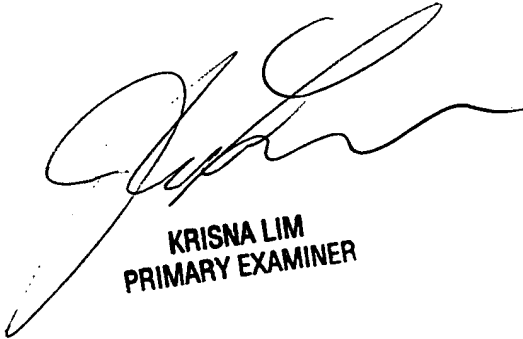


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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

July 7, 2005



KRISNA LIM  
PRIMARY EXAMINER